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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,298	03/09/2004	Mark D. Elkovitch	134380-2	4441
23413 7590 03/13/2007 CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			EXAMINER THOMAS, JAISON P	
			ART UNIT	PAPER NUMBER
			1751	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/13/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/797,298	ELKOVITCH, MARK D.	
	Examiner	Art Unit	
	Jaison P. Thomas	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 25-40 and 42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) is/are allowed.
- 6) ☒ Claim(s) 1-17, 20-24 AND 41 is/are rejected.
- 7) ☒ Claim(s) 18, 19 is/are objected to.
- 8) ☐ Claim(s) are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u> </u> |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u> </u> | 6) <input type="checkbox"/> Other: <u> </u> |

DETAILED ACTION

1. This action is responsive to amendments filed on 12/11/2006.
2. Claim 1 has been amended. Claims 25-40 and 42 are withdrawn from consideration.
3. Claims 1-17, 20-24 and 41 stand rejected under 35 USC 102(b) as being anticipated by Shibuta (WO 97/15935).
4. Claims 4-8 and 11-14 stand rejected under 35 USC 103(a) as unpatentable over Shibuta (WO 97/15935) in view of Applied Nanotech Inc. (ANI) webpage (<http://www.applied-nanotech.com/cntproperties.htm>).
5. Claims 18 and 19 remain allowable over the prior art of record.

Response to Arguments

6. Applicant's arguments filed 12/11/2006 have been fully considered but they are not persuasive.

With respect to the Shibuta rejections, Applicant argues that Shibuta requires electrically conductive metal oxides whereas as the instant claims are directed towards non-conductive nanodispersion agents. Applicant further argues that the non-conductive powders that are disclosed in Shibuta are coated with a conductive surface and cites sections of Shibuta to support this position. With respect to the Shibuta rejections made in view of the ANI webpage, Applicant contends that Shibuta in view of the ANI webpage does not contain all the elements of the instant claims and therefore cannot render the claims obvious. Applicants respectfully submit that there is no

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evidence supporting the publication date of the ANI webpage and thus it is not available as prior art and further argues that the ANI webpage does not disclose single walled nanotubes as of the date of the present application. Finally, the applicant argues that there is no motivation to modify Shibuta with the webpage since Shibuta teaches away from the present claims. Shibuta teaches the addition of electrically conductive particles to improve conductivity of the Shibuta composition which one of ordinary skill would expect whereas Applicant's composition has the unexpected result of the improved conductivity via the addition of electrically non-conductive particles.

The Examiner respectfully disagrees with the Applicant, because as stated in the prior office action, Shibuta teaches a composition that contains a polymeric resin, nanotubes, and metal oxides which are equivalent to the compositions that are claimed and disclosed in the Applicant's specification. The metal oxides include titanium oxide and zinc oxide (see pg. 7, lines 11 and 12) used in Shibuta are identical to the nanodispersion agents disclosed in Applicant's specification and claims (see instant Claim 23 and Specification, pg. 14, para. 0040). Therefore the nanodispersion agents of the instant claims and the metal oxides of Shibuta are identical and mere reference to claimed set as "non-conductive" and the prior art set as "conductive" does not change this fact. Further, the Examiner respectfully is unclear as to where Applicant believes the metal oxides of Shibuta are coated with a conductive surface. The Examiner has checked the sections cited by Applicant in his Remarks (particularly citations of Shibuta at pg. 7, lines 29-34 and pg. 8, lines 9-10) in the Shibuta PCT reference and has found

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no support for the statements that the said metal oxides from Shibuta are coated with any conductive surfaces.

In regards to the availability of the ANI webpage as prior art, the Examiner has attached a copy of webpage taken from the Internet Archive website (<http://web.archive.org>) which shows that the ANI webpage cited in the first office action was available on the Internet as of 4/5/2003 which predates Applicant's effective filing date of 5/22/2003. With respect to the argument concerning single walled nanotubes, the ANI webpage clearly illustrates a picture and drawing of such nanotubes on pg. 2 of the reference. Finally, with respect to motivations of combination, the Examiner respectfully submits that the references were combined to illustrate the common properties of the carbon nanotubes that are used in the Shibuta reference in order to address the dependent claim limitations and not for the purposes of modifying the conductivity properties of the Shibuta composition. Finally, the Shibuta compositions do not teach away from the instant claimed composition but teach identical compositions to those which are claimed and therefore a motivation to modify the reference exists.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaison P. Thomas whose telephone number is (571) 272-8917. The examiner can normally be reached on Mon-Fri 8:30 am to 5:00 pm.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jaison Thomas
Examiner
3/1/2007

JT

Lorna M. Douyon
LORNA M. DOUYON
PRIMARY EXAMINER